

Application No.: 09/970,789
Reply to Office Action of 3/27/2006

REMARKS

The non-final Office Action of March 27, 2006, has been carefully reviewed and these remarks are responsive thereto. Claims 1-10 and 38-41 have been canceled without prejudice or disclaimer. New claims 42-55 have been added, and claims 11, 17-18, 22, 31, 33, 35, and 36 have been amended to further clarify the scope of protection. Claims 11-37 and 42-55 are pending. Reconsideration and allowance of the instant application are respectfully requested.

Claim Objections

Claim 36 stands objected for grammatical reasons. Applicants have amended claim 36 to present the claim in a more preferred form and respectfully request the objection be withdrawn.

Rejections Under 35 U.S.C. § 112

Claims 5 and 6 stand rejected under 35 U.S.C. § 112. Applicants have cancelled claims 5 and 6 by the present amendment, thereby rendering the rejection moot.

Rejections Under 35 U.S.C. § 103(a)

Pending claims 11-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McClelland (U.S. Patent No. 6,707,879, hereinafter *McClelland*) in view of Moore (U.S. Patent No. 6,246,778, hereinafter *Moore*). Applicants respectfully traverse the rejection.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine *McClelland* with *Moore*. The invention disclosed in *McClelland* enables spatial separation between the location of the goods and the location of the human inspector. This spatial separation is an essential part of the *McClelland* invention. The *McClelland* patent is titled "Remote Baggage Screening System, Software and Method" (emphasis added). In the "Summary of Invention" section, *McClelland*

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describes three embodiments of the invention. The first embodiment includes “a system for baggage-screening that is remotely monitored and controlled.” (column 2, line 25). The second embodiment is described as being “for remote screening of items under inspection.” (column 2, line 46) The third is for “remote inspection of items.” (column 2, lines 63-64) This emphasis on the goods being remotely located teaches away from inspecting goods in person, as claimed. Consequently, there is no suggestion or motivation to combine *McClelland* with any reference that facilitates the in-person inspections *McClelland* was designed to avoid, such as Moore.

Moore assumes and facilitates the in-person inspection process *McClelland* tries to eliminate. As noted in the Office Action, *Moore* includes a field reader. Just as its name implies, the field reader is used in the field – at the location of the goods being inspected. Its features, such as displaying data obtained from a central server, would only be useful to someone performing an in-person inspection. There is no motivation or suggestion in either reference to combine *McClelland* and *Moore*. Applicants respectfully submit that the first prong of a *prima facie* case of obviousness has not been met, and therefore the reference teachings should not be combined.

Further, the claim limitations of amended independent claims 11, 22, 31, and 35 are not taught or suggested by the prior art of record, even if combined. For example, claims 11 and 22 contain a step that includes receiving a task list “wherein each task comprises information known about a unique shipment of goods prior to the shipment being inspected.” Lee (U.S. Patent Publication No. 2003/0023469) does not include a client-side task list. *McClelland* makes no reference to using any pre-existing data. *Moore* is able to read a tag from the goods being inspected, but the authentication in *Moore* is based solely on the contents of this tag, which serves as a unique identifier. There is no notion of the tag containing information about the shipment of goods itself or of the field reader displaying any such information. Therefore, the prior art of record fails to teach or suggest the features of claims 11 and 22.

As a further example, claims 31 and 35 include, among other features, a database wherein each entry is representative of a task. Such a database is not taught or suggested by the prior art of record. For at least the foregoing reasons, claims 11-37 are allowable. Dependent claims 12-21, 23-30, 32-34, and 36-37 are distinguishable over the prior art of record for at least the same reasons as their ultimate base claims and further in view of the novel features recited therein.

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New Claims

New claims 42-55 have been added by the present amendment. These claims are fully supported by the original written description and drawings and do not add new matter. For at least similar reasons to those described above with reference to claims 11 and 22, independent claim 42 is allowable. Claims 43-51 depend on claim 42, and are allowable for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Claims 52 and 53 describe user interfaces for a task list. The prior art of record fails to teach or suggest the user interfaces recited in claims 52 and 53. These claims are therefore allowable. Claims 54 and 55, which depend on claim 53, are allowable for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Conclusion

Applicants respectfully submit that the instant application is in condition for allowance and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,
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